

Atty. Dkt. No. 072827-1905

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons which follow. In order to facilitate prosecution, Applicant has amended the claims such that only claims 5-6 and 21-24 remain in this application. Thus the pending claims are those that the Examiner indicated are free of the art.

Claim 5 is currently being amended.

Claims 1-4 and 7-20 are cancelled.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 5-6 and 21-24 are now pending in this application.

Election/Restrictions

Applicant appreciates the Examiner's indication that the elected specie and claims 5-6 and 21-24 are free of the art, and expansion of the search to include additional claims. In order to facilitate prosecution, all claims other than claims 5-6 and 21-24 are cancelled in this Amendment. The cancellation of claims is intended to focus on claims on subject matter that the Examiner recognized was free of the art, and allow rapid allowance of those claims. That cancellation does not constitute an admission that any of the subject matter of the cancelled claims is unpatentable.

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Rejections under 35 U.S.C. § 112, First Paragraph

The Examiner asserted that the specification failed to provide an adequate written description of compounds having an NMDA IC₅₀ of about 50 nM to about 1 μ M, and a serotonin reuptake IC₅₀ of less than or equal to 100 nM. Unfortunately, the Examiner did not identify which claim or claims were rejected on this basis. While the Examiner did not identify the rejected claims, the substance of the Examiner's comments suggests that claim 1 was intended. Applicant has cancelled claim 1 above. Therefore Applicant respectfully submits that this rejection is inapplicable to the present claims.

Rejections under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 1-6 and 19-24 under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. Applicant respectfully traverses these rejections as they may be considered in connection with the claims above. Because claims 1-4 and 19-20 were cancelled above, Applicant respectfully submits that those rejections are rendered moot and does not discuss those rejections below.

In connection with the rejection of claim 5, the Examiner asserted that there is insufficient basis for the term "the chemical structure". Applicant respectfully traverses this rejection as it may be applied to the pending claims. Prior claim 5 provided definite meaning for the use of the term "the chemical structure" by immediately following the use of that term with a particular chemical structure. Such usage is conventional in specifying particular compounds, and Applicant respectfully submits that there is no indeterminacy or indefiniteness present through the use of the cited term. Nonetheless, to further emphasize the relationships between the cited term and the chemical structure, claim 5 is amended above to specify "the following chemical structure". Thus, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection as applied to present claims 5 and 6.

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Rejections under 35 U.S.C. § 103

The Examiner rejected claims 1-4 and 19-20 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Jones et al. (*Potential Antidepressants*, *J. Med. Chem.*, 1971, 14:161-164) and further in view of Nowak et al. (*Eur. J. Pharmacol.*, 1998, 342:367-370).

While Applicant does not concur that any of the claims are unpatentable over Jones et al. and Nowak et al., all of the rejected claims are cancelled above. Therefore, Applicant submits that the rejections under 35 U.S.C. § 103(a) are inapplicable to any of the pending claims, and respectfully requests that the Examiner withdraw these rejections.

Applicant believes that the present application is now in condition for allowance. The only rejections against pending claims 5-6 and 21-24 were the rejections under 35 U.S.C. § 112, second paragraph. In view of the amendments of claim 5 herein and consistent with the Examiner's indication that the pending claims are free of the art, Applicant respectfully submits that the pending claims are allowable. Thus, favorable reconsideration of the application as amended is respectfully requested.

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The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-0872.

Respectfully submitted,

Date: May 7, 2004

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